

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

YOR920010281US1 (8728-513)

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on _____

Signature _____

Typed or printed name _____

Application Number

09/845,708

Filed

April 30, 2001

First Named Inventor

Challenger et al.

Art Unit

2178

Examiner

Paula, Caser B.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Nathaniel T. Wallace/

Signature

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Nathaniel T. Wallace

Typed or printed name

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516.692.8888

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☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

April 7, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Challenger et al.	Docket: YOR920010281US1 (8728-513)
Serial no.:	09/845,708	Confirmation: 2686
Examiner:	Paula, Cesar B.	Art Unit: 2178
Filed:	April 30, 2001	
For:	A METHOD FOR GENERATION AND ASSMEBLY OF WEB PAGE CONTENT	

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Examiner:

In response to the Advisory Action dated April 1, 2010, Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal and a Pre-Appeal Brief Request For Review Form (PTO/SB/33).

A previous Appeal was reopened on the basis of a Pre-Appeal Brief Request. Therefore, Applicants respectfully request that the previously paid Notice of Appeal fee (fee under 41.20(b)(1)) be reapplied. The difference (\$40.00) between the current increased fee and the amount previously paid is attached hereto.

REMARKS

Please consider the following reasons for this Pre-Appeal Brief Request for Review. Claims 16, 17, 19-21, 24, and 32-38 are pending. Reconsideration of the rejections in view of the remarks is respectfully requested. Only rejections pertinent to independent claims are addressed herein.

Claims 16, 17, 19-21, 32-36 and 38 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Troyansky et al. (US Application No. 2003/0190054) in view of Lewis (Lewis, R., “Adobde Pagemill 2.0 Handbook,”) and further in view of Levy et al. (US Application No. 2003/0012548).

Referring to Claim 16; Troyansky teaches a method for providing uniquely marked copies of data content via digital watermarks (see Abstract and paragraph [0124]). Troyansky further teaches a content processor that forms the sets of marked segments prior to distribution of the data content (see paragraph [0114]). The assembly of Troyansky is performed by a server (see FIG 3). Further, the data stream with the embedded message is part of the reply. Compare Claim 16, wherein “the reply does not include the textual content in the image format.” Therefore, Troyansky does not teach or suggest, “generating an HTML document containing an inline reference to the stored textual content in the image format”, much less that “the reply does not include the textual content in the image format”, essentially as claimed in Claim 16.

Lewis teaches that HTML tells a computer how to interpret hypertext documents (see page 13, second paragraph). Lewis does not teach or suggest, “generating an HTML document containing an inline reference to the stored textual content in the image format” as claimed in Claim 16. Lewis generates HTML code, which may include tags (see page 139, line 3).

HTML treats images as text as argued by the Examiner only to the extent that an image can be referred to by a tag. Nothing in Lewis teaches or suggests that text is converted by a server to an image format according to a content creation preference. Since Lewis in no way teaches or suggests a page layout program executed on a server for dynamically creating images of textual content in response to a request, Lewis fails to cure the deficiencies of Troyansky.

Levy teaches that a server performs integration of a watermark in content (see paragraph [0093]). Levy does not teach or suggest “generating an HTML document containing an inline reference to the stored textual content in the image format” as claimed in Claim 16. In Levy’s method a client is a creator of content and watermarked content desiring to tailor audio or video content presented to consumers (see paragraphs [0078] and [0033]). Levy’s client is very different from the client of Claim 16 - the client of Claim 16 is a requestor of content from the server. Levy’s client is a provider of content to the server. More particularly, Levy teaches that content, a watermark and watermark parameters are sent to a server for integration and returned as a complete document for later broadcast to consumers. Clearly this is not analogous to retrieval and inline dynamic assembly by the client, essentially as claimed in Claim 16 – Levy does not teach an inline reference. Moreover, the server of Levy returns content as a complete document for later broadcast to consumers. Such a reply is clearly distinguishable from a “reply [that] does not include the textual content in the image format”, as claimed in Claim 16. Therefore, Levy fails to cure the deficiencies of Troyansky and Lewis.

The combination of Troyansky, Lewis and Levy teach a server embedding content into data. The combination of Troyansky, Lewis and Levy fail to teach or suggest, “generating an HTML document containing an inline reference to the stored textual content in the image

format” or a “reply [that] does not include the textual content in the image format” as claimed in Claim 16.

Referring to Claim 35; Claim 35 is believed to be allowable for at least the reasons given for Claim 16. Claim 35 is believed to be allowable for additional reasons.

The combined teachings of Troyansky, Lewis and Levy teach tags referring to images in a file together with HTML code - such a tag is not a uniquely addressable element as claimed. The combined teachings of Troyansky, Lewis and Levy fail to teach or suggest, “storing the textual content in the image format as a uniquely addressable element identified by a Uniform Resource Locator (URL)” as claimed in Claim 35. The tags of Troyansky, Lewis and Levy merely have directory addresses associated with the file. A file directory address is not analogous to the claimed URL, much less a URL created dynamically in response to a request, essentially as claimed.

Finally, the rejection relies on the suggestion that Lewis (Pagemill) “teaches an Internet server receiving a request for a tagged HTML file. In response, the Internet server communicates the HTML file in textual format to a requesting client computer. The images are treated as text by the HTML format (page 12, parag.3-page 13, page 18-20). In other words the reply, which the server sends to the browser, only includes the html textual code, and not the watermarked image as recited in the independent claims 16, and 35” (see Final Office Action, page 8).

Even assuming the suggestion is correct, the watermarked images are simply not textual content in image format as claimed. That is the combination of references fails to teach a replacement of format that preserves the content. For example, FIG. 3 of the application shows an example in which the word “first” is converted from textual format to image format, while the content, the usage of the word “first”, is conserved. Compare Troyansky; the watermark replaces

first content with second different content. The watermark does not include the conversation of particular content from textual format to image format; note that the claims are specific that the content does not change with the conversation from a textual format to an image format.

For at least the foregoing reasons, there is believed to be clear error in the rejection. Claims 17, 19-21 and 32-34 depend from Claim 16. Claims 36 and 38 depend from Claim 35. The dependent claims are believed to be allowable for at least the reasons given for Claims 16 and 35, respectively. Reconsideration of the rejection is respectfully requested.

Claims 24 and 37 have been rejected under 35 USC 103(a) as being unpatentable over Troyansky, Lewis, Levy and further in view of Minematsu (US 6,700,993). Claims 24 and 37 depend from Claims 16 and 35, respectfully, and are believed to be allowable for at least the reasons given for the independent claims.

For the forgoing reasons, the application, including Claims 16, 17, 19-21, 24, and 32-38, is believed to be in condition for allowance. Early and favorable reconsideration of the case is respectfully requested.

Respectfully submitted,

Dated: April 7, 2010

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